



UNITED STATES PATENT AND TRADEMARK OFFICE

Y
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/426,792 | 10/22/1999 | DENNIS T. MANGANO | 27116-701.301 | 2354 |
| 21971 | 7590 | 06/23/2005 | EXAMINER | |
| WILSON SONSINI GOODRICH & ROSATI 650 PAGE MILL ROAD PALO ALTO, CA 94304-1050 | | | SPIVACK, PHYLLIS G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1614 | |

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/426,792 | MANGANO, DENNIS T. | |
| | Examiner | Art Unit | |
| | Phyllis G. Spivack | 1614 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 April 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4,6,15,16,50,51,53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4,6,15,16,50,51,53 and 54 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Applicant's Amendment filed April 8, 2005 is acknowledged. Claims 5, 7-14, 17-49 and 52 are/were canceled. Claims 1-4, 6, 15, 16, 50, 51, 53 and 54 remain under consideration.

A Declaration under 37 CFR 1.132 filed April 8, 2005 is further acknowledged.

Applicant's arguments with respect to the rejection of all claims under 35 U.S.C. 103 as being unpatentable over Goldstein et al., J. Cardiovascular Pharmacology, particularly in view of Kataria et al., J. Cardiothoracic Anest., in the last Office Action have been considered but are moot in view of the new ground of rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 15, 16, 50, 51, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merrick et al., European Journal of Cardio-thoracic Surgery.

Merrick teaches the administration of the beta-blocker atenolol or the weak beta-blocker propafenone to reduce cardiovascular disease complications, such as postcardiotomy supraventricular tachyarrhythmias, in a patient following surgery. See page 148, column 2, second paragraph. See column one, page 147, where the drugs were orally administered daily from the first postoperative day, or as soon as the patient was able to take oral medication, until the 7th postoperative day, or until an endpoint was reached. In Applicant's Declaration the recitation "immediately after surgery" in relation to administration of a pharmacologic cardiovascular agent is stated to mean that

Art Unit: 1614

administration occurs *prior to a patient's emergence from anesthesia* immediately following surgery. Merrick teaches the administration of the beta blocker to be in the immediate postoperative period. No distinction is seen between "the immediate postoperative period" and "immediately after surgery". The limitations in claim 1, i.e., a heart rate greater than or equal to 65 bpm, systolic blood pressure greater than or equal to 100 mm Hg, no evidence of congestive heart failure, third degree block or bronchospasm, are the desired parameters reasonably sought. See Table 2 where variables, as required by claims 15, 16 and 50, such as diabetes, hypertension, previous cardiac surgery and coronary artery disease, are listed. The determination of a maximum effective dose of the beta blocker, as well as an optimal dosing regimen, are well within the purview of those skilled in the art through no more than routine experimentation. Considerations, such as the age, weight, renal and hepatic status of the patient and the particular cardiovascular complication contemplated, would factor into the determination of a maximum effective dose.

No claim is allowed.

Applicant's Amendment necessitated the new ground of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this Final Action is set to expire THREE MONTHS from the mailing date of this Action. In the event a first reply is filed within TWO MONTHS of the mailing date of this Final Action and the Advisory Action is not

Art Unit: 1614

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the Advisory Action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the Advisory Action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this Final Action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Phyllis G. Spivack whose telephone number is 571-272-0585. The Examiner can normally be reached Mondays to Fridays from 10:30 AM to 7 PM.

If attempts to reach the Examiner by telephone are unsuccessful after one business day, the Examiner's supervisor, Chris Low, can be reached at telephone number 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/426,792

Art Unit: 1614

Page 5



Phyllis G. Spivack
Primary Examiner
Art Unit 1614

PHYLLIS SPIVACK
PRIMARY EXAMINER

June 20 11, 2005